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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,325	07/23/2003	Douglas G. Guenther	WT0115	7745

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Terence P. O'Brien  
Wilson Sporting Goods Co.  
8700 W. Bryn Mawr Avenue  
Chicago, IL 60631

EXAMINER
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WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/625,325

Applicant(s)

GUENTHER ET AL.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 51-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-14 and 51-64 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-3, 5, 7, 9, 10 and 51-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931). Note the basis for the rejections set forth in the Office Actions mailed February 16, 2005 and August 24, 2005. Regarding the added limitation to claim 1, the combination of Horkan in view of Martin would teach a highly grippable surface for the laces. The ball of Horkan in view of Martin is obviously capable of being used in competitive play.

3. Claims 4, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931) and Feeney (6,283,881). Note the basis for the rejection set forth in the Office Action mailed February 16, 2005.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931) and Finley (4,991,842). Note the basis for the rejection set forth in the Office Action mailed February 16, 2005.

5. Claims 1-3, 5, 7, 9, 10 and 51-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931) and Yang (6,520,877). Yang discloses a basketball construction including a plurality of grained leather panels (5) and a plurality of ribs separating the panels. The ribs are provided with raised grains (411) in order to improve the grip of the ball during use. The reference to Yang therefore, teaches that it is well known in the art of sports balls to provide raised projections across the entire surface in order to improve the grip of the ball. Therefore, it would have been obvious to one of ordinary skill in

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the art to replace the hook and loop fastening system of Horkan with a raised projections in order to provide a simpler means of improving the grip of the football.

6. Claims 4, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931), Yang (6,520,877) and Feeney (6,283,881).

Regarding claim 4, it would have been obvious to one of ordinary skill in the art to provide differently shaped projections on the laces of the ball of Horkan as modified by Martin and Yang in order to arrange a particular design for the ball while still improving the grip.

Regarding claim 8, the projections of Feeney are of varying sizes.

Regarding claim 12, Horkan teaches hook fasteners along the entire surface of the lacing. To replace the hook fasteners with the projections of Martin would obviously also place projections along the entire length of the lacing.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931), Yang (6,520,877) and Finley (4,991,842). It would have been obvious to one of ordinary skill in the art to randomly place the projections on the laces of the ball of Horkan as modified by Martin and Yang in order to provide a particular design pattern for the laces.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

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*Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 of U.S. Patent No. 6,629,902 or claim 1 of U.S. Patent No. 6,767,300. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims a football with lacing having a pebble-like surface.
2. Claims 4, 8 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 or claim 1 of U.S. Patent No. 6,767,300 each in view of Feeney (6,283,881). Feeney teaches projections for a sports ball that are generally triangular and generally rectangular. It would have been obvious to one of ordinary skill in the art to provide the lacing of the patents with differently shaped projections in order to arrange a particular design for the ball while still improving the grip.
3. Claims 5, 7, 9, 10 and 51-64 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 claim 1 of U.S. Patent No. 6,767,300 each in view of Martin (4,570,931). It would have been obvious to one of ordinary skill in the art to form the projections of the patents with the shapes and arrangement of Martin in order to provide an alternative shape and arrangement for the textured surface of the lacing.

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4. Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,629,902 claim 1 of U.S. Patent No. 6,767,300 each in view of Finley (4,991,842). It would have been obvious to one of ordinary skill in the art to provide the surface of the laces of the patent with randomly spaced projections in order to provide a particular design to the laces.

5. Claims 13 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 5 of U.S. Patent No. 6,629,902 in view of Feeney (6,283,881). Feeney teaches projections for a sports ball that are generally triangular and generally rectangular. It would have been obvious to one of ordinary skill in the art to provide the lacing of the patent with differently shaped projections in order to arrange a particular design for the ball while still improving the grip.

***Response to Arguments***

9. Applicant's arguments filed February 23, 2006 have been considered but are not persuasive. The applicant maintains his argument that there is no suggestion to combine the teachings of Horkan and Martin and states that the references teach away from such a combination. However, this argument is still not persuasive as the Martin reference teaches that it is well known in the art of sports balls to provide pebbles or raised surfaces in order to improve the grippability of the ball. The reference to Horkan teaches that it is well known in the art of sports balls and particularly footballs to provide the lacings with a textured surface in order to improve the grippability of the ball. The suggestion to combine the teachings is that both references are directed towards improved grippability of a sports ball and both particularly teach textured surfaces for achieving this purpose.

Further, it is noted that a rejection over the combination of Horkan in view of Martin and Yang is set forth above. The reference to Yang adds to the combination a teaching that it is well known in the art of sports balls to provide raised projections not only on the typical panels of the ball but also the seams separating the panels. Thus, Yang gives a teaching to one of ordinary skill in the art to provide raised projections on the entire surface of the football including the laces for improving the grippability of the ball.

Regarding the applicant's argument that neither Horkan nor Martin teach a football for use in competitive play, the recitation does not result in a structural difference between the claimed invention and the prior art. The prior art structure created by the combination of Horkan in view of Martin is obviously capable of being used in competitive play. Moreover, it is noted that competitive play could simply be an informal game where a score is kept and does not necessarily imply any required regulations as to size and weight for the ball such as would be required by a professional league.

Regarding the applicant's multiple citations of Horkan emphasizing that the ball is to be grasped only at the laces and only with the use of the corresponding glove, while this may be true, the rejection is over the combination of Horkan in view of Martin. The citations of Horkan further exemplify that Horkan is indeed concerned with improved grippability of the user at the laces. While Horkan teaches a particular relationship between the user and the ball (the hook and loop fasteners) the broader teaching of Horkan is that the laces of a football may be textured for improving the grasping and control of the football. The reference to Martin teaches that this improved grasping and control of a sports ball may be accomplished by providing raised projections.

Regarding the applicant's argument that Horkan teaches away from a highly grippable lacing, it is the combination of Horkan in view of Martin that teaches this structure. The reference to Horkan teaches that it is well known in the art of sports ball and particularly footballs to provide the lacing with a textured surface in order to improve the user's grasping and control of the ball. The reference to Martin teaches that improved grasping and control of a sports ball may be also accomplished by providing the ball with raised projections.

Regarding the affidavit submitted February 23, 2006, it is been considered, however it is not persuasive in overcoming the rejections set forth above. The applicant argues that the test results show the coefficient of friction for the hook and loop fasteners is substantially less than that of the materials provided by the instant invention. While this may be true, the rejection is over the combination of Horkan in view of Martin where the hook and loop fasteners are replaced with the raised projections of Martin. Further, claim 1 does not define any coefficient of friction as set forth in the test results and merely recites a "highly grippable" surface. The combination of Horkan in view of Martin is seen as teaching this limitation.

Regarding the reference to Feeney, this reference is relied upon merely for its teaching that it is well known in the art of sports balls to provide projections of other shapes.

Regarding the reference to Finley, this reference is relied upon merely for its teaching that it is well known in the art of sports balls to randomly place projections on the surface of the ball.

Regarding the obviousness-type double patenting rejections, the applicant argues that Terminal Disclaimers have been submitted overcoming the rejections. However, a review of the application reveals only Terminal Disclaimers disclaiming D457,208 and D480,774 have been



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submitted. A review of the papers submitted June 10, 2005 shows only a Terminal Disclaimer disclaiming D480,208 which was held to be improper.

***Allowable Subject Matter***

10. Claim 11 appears to read over the prior art of record.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

~~Steven Wong~~  
Primary Examiner  
Art Unit 3711

SBW  
April 24, 2006